UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,353	02/23/2004	Kenneth L. Miller	075234.0131	2325

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BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

EXAMINER
HSU, RYAN

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
07/11/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mike.furr@bakerbotts.com
ptomail1@bakerbotts.com

Office Action Summary	Application No.	Applicant(s)
	10/784,353	MILLER, KENNETH L.
	Examiner	**Art Unit**	
	Ryan Hsu	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 April 2007</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17 and 22-35* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17 and 22-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All   b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

In response to the amendments filed on 6/18/07, claims 9 and 27 have been amended and

claims 18-21 have been canceled without prejudice and claims 30-35 have been newly added.

Claims 1-17, 22-35 are pending in the current application and claims 30-35.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

Claims 31 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the enablement requirement. The claim(s) contains subject matter, which was not described

in the specification in such a way as to enable one skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention. The claims are directed

towards the first player having a selection of event contest not being included in a plurality of

event contests selected by the second player. This could refer to either that the second player has

a different set of contests selected or that the first player's selections are then not offered to the

second player. Nevertheless, both interpretations are not disclosed in the applicant's

specification. Additionally, claim 33 is directed towards making a wager after an event contest

has already begun however, there is no disclosure of what the system will do in the applicant's

specification. If the applicant's representative disagrees it would be greatly appreciated if it a

citation to the specification were given.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 14-17, and 22-29, are rejected under 35 U.S.C. 102(e) as being

anticipated by Brenner et al. (US 5,830,068 A).

Regarding claim 1, Brenner discloses a method of wagering on horse races in an event

having races (*ie: a horse track facility*), the method comprising: predetermining a quantity of the

event's races to be included in a wager (*see col. 2: ln 45-50*); allowing a player to choose the

event's races to be included in a wager, wherein the player is required to choose a plurality of a

number of chosen races equal to the predetermined quantity of the event's races (*see col. 4: ln

22-42, "pick-n" and "daily double" wagers of col. 6: ln 10-20*); allowing the player to select a

winner for each of the chosen races, the selected winners included in the wager (*see col. 4: ln 30-

35*); and paying the player if a predetermined number of the selected winners win corresponding

chosen races (*see col. 4: ln 33-42*). Additionally, it is noted that the ability to allow a player to

choose a wager in an interactive wagering system would be an inherent activity. Furthermore, it

is also inherent in the wager that a player gets to choose what wager's are to be included in an

event as if they were not given this flexibility in the wagering system a player would not be able

to accurately portray what he/she would like to wager into the system.

Regarding claims 6 and 29, Brenner discloses a method of wagering on horse races in an

event having a plurality of races, the method comprising: receiving information specifying a

predetermined number of event races to be included in a wager (*see col. 2: ln 45-50*); selecting

event races to be included in the wager, the number of selected races equal to the predetermined

number of event races (*see col. 22: ln 42*); selecting a winner for each of the selected races in the

wager (*see col. 4: ln 30-35*); and receiving a payout if a predetermined number of selected

winners win corresponding chosen races (*see col. 4: ln 33-42*). Additionally, Brenner discloses a

method of wagering on horses further comprising placing a bet on the selected winners (*see Fig.

13 and the related description thereof*).

Regarding claim 14, Brenner discloses a placing a wager in an event having races, the

wager comprising a bet that a particular entry selected by a better in each of a plurality of the

races will be a winning entry (*ie: system is capable of placing different types of wagers, and a

pick-n wager would enable a winning entry if the bettor picks the winning participant in each of

the races*), wherein the plurality of races comprise a predetermined number of races that are

selected by the bettor (*see col. 4: ln 22-42, col. 6: ln 1-26*).

Regarding claims 15-16, Brenner discloses a method of accepting bets on an event having

a plurality of event contests, the method comprising: selecting a predetermined quantity of the

event contests for a wager; receiving from a user a selection of event contests, from among the

plurality of event contests to be included in the wager, the number of selected event contests

corresponding to the predetermined quantity of event contests; and receiving from the user a

selection of contestants corresponding to each of the selected event contests (*see col. 4: ln 22-

42*). Additionally, Brenner discloses a method that comprises receiving from the user a bet on

the selected contestants (*see col. 4: ln 22-42*).

Regarding claims 25-26, Brenner discloses a system for betting on an event having a plurality of event contests, comprising: a processor operable to determine a predetermined quantity of the event contests for a wager (*see Fig. 27 and the related description thereof*); and an interface coupled to the processor and operable to: receive from the user a selection of event contests, from among the plurality of event contests, to be included in the wager, the number of selected event contests corresponding to the predetermined quantity of event contests (*see col. 4: ln 22-42*); receive from the user a selection of contestants corresponding to each of the selected event contests; and wherein the processor is further operable to determine based on whether a predetermined number of selected contestants won the corresponding selected event contests, if the user is a winner (*see col. 7: ln 35-54*). Additionally, Brenner discloses an interface further operable to receive from the user a bet on the selected contestants (*see Fig. 13 and the related description thereof*).

Regarding claims 27-28, Brenner discloses logic embodied in a computer readable medium, the computer readable medium comprising code operable to: select a predetermined quantity of the event contests for a wager (*see Fig. 10 and 12 and the respective related descriptions thereof*); receiving from a user a selection of event contests, from among the plurality of event contests, to be included in the wager, the number of selected event contests corresponding to the predetermined quantity of event contests (*see col. 4: ln 22-42*); and receive from the user a selection of contestants corresponding to each of the selected event contests; and determine, based on whether a predetermined number of selected contestants won the corresponding selected event contests, if the user is a winner (*see col. 7: ln 35-54*). Additionally, Brenner discloses the logic in a computer readable medium comprising code further operable to

receive from the user a bet on the selected contestants (*see Fig. 13 and the related description thereof*).

Regarding claims 2-3 and 22, Brenner discloses a method of wagering on horse races wherein the predetermined quantity of the event's races included in the wager is less than a total number of races in the event which is an inherent feature in betting since a wager by nature is a choosing what the outcome of an event. For example, if one were to choose the entire field of contestants since it will always be true in a racing event that at least one person in the entire field will win. Additionally, Brenner discloses a wagering system that discloses a limitation where a wager queue is used to transmit information from the terminals to the database. Brenner discloses that in its system a user may place additional wagers but is limited by the state of the queue to five wagers per form (*see col. 12: ln 9-26*). Brenner states that the wager queue is physically limited to space for five wagers before any additional wagers may be added and a user is not limited to only placing five wagers in an event but may only place the predetermined number of five wagers at one time (*see col. 12: ln 9-26*).

Regarding claims 4-5 and 23-24, Brenner discloses an interactive wagering service that links up a player's wagers to an account wherein the player is paid if the player's wagers match the winners of all or some of the races in the wagers they have selected (*see Fig. 31 and the related description thereof*). Additionally, Brenner discloses the implementation of wagers, which allows a player to cash in the ticket if the predetermined conditions of the wager are met, but a predetermined number of selected winners are less than a total number of winners for the chosen races (*see col. 2: ln 34-col. 4: ln 25*). As a result, Brenner's system pays the players if the predetermined number of selected winners win corresponding chosen races comprises

playing the player if all of the selected winners win corresponding chosen races (*see col. 4: ln 22-42*).

Regarding claim 17, Brenner discloses a method that comprises paying the user if a predetermined number of the selected contestants win a corresponding selected event contest (*see col. 4: ln 22-42*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-12, 30, 32, and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner et al. (US 5,830,068 A) as further evidenced by Scarne's New Complete Guide to Gambling.

Regarding claims 9 and 30, Brenner teaches a computer assisted method for administering betting on a plurality of races within a racing event using a computer for assistance, comprising: publishing race information associated with a racing event to a plurality of players for use in wagers (*ie: totalisators*) (*see col. 3: ln 30-67*). Additionally, Brenner teaches establishing a predetermined quantity of the event races to be included in wagers receiving a first selection of a subset of the plurality of races within the racing event from each of the plurality of players (*see col. 4: ln 22-33*), the number of races in the first selection corresponding to the predetermined quantity and receiving a second selection of predicted winners from each of the plurality of players, each of the predicted winners corresponding to at

least one of the races in the first selection (*see col. 7: ln 35-54*), the first and second selections of

the each player included in a wager corresponding to the player (*ie: daily double*). Furthermore,

Brenner teaches receiving from each of the plurality of players a bet associated with the wager

corresponding to that player and receiving result from each race within the racing event and

identifying a set of winning players from the plurality of players by determining which of one or

more players of the plurality of players correctly selected each predicted winner in the selection

for each race and sending the winning players the prize (*see col. 6: ln 10-27, col. 5: ln 59-col. 6:*

ln 9)). However, although it is inherent that horse betting operations are pari-mutuel pools,

Brenner does not explicitly recite the incorporation of forming at least a portion of each bet to

form a pool and sending at least a portion of the pool to each of the identified winning players

(*see pg. 32-55*). However, as is evidenced by Scarne's horse betting wagers have revolved

around the use of what is known as pari-mutuel pools in order to derive the odds for a horse race

and thus the payout is generated from the result of the betting habits of the bettors involve.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention

was made to incorporate the teachings of Scarne on the mathematics of horse betting with that of

Brenner to realize that the wagers that are discussed in Brenner are related to that of pari-mutuel

pools.

Regarding claims 10-11, Brenner discloses a computer-assisted method wherein the first

selection of the subset of the plurality of races and the second selection of predicted winners for

each race in the second selection is associated with a game card (*see smart card [122] of Fig. 2*

and the related description thereof). Additionally, the data on the game card is transferred to a

computer (*see Fig. 6 and the related description thereof*).

Regarding claims 12, Brenner discloses a computer-assisted method wherein results from each race within the racing event are input into a computer (*see col. 2: ln 35-50*).

Regarding claim 32, Scarne discloses a method wherein the event contests in the first plurality of event contest comprise non-consecutive event contests within the event (*see daily double*).

Regarding claims 34-35, Scarne teaches a method of calculating a payout amount for the at least one winning player based on a total of the betting pool (*see pg. 32-55*). Additionally, Brenner's system initiates a payout of the payout amount to the at least one winning player. (*see smart card [122] of Fig. 2 and the related description thereof*)

Claims 7-8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner et al. as applied to claims above, and further in view of "TAB: How to Play – Betting Options".

Regarding claims 7-8 and 13, Brenner teaches a method of wagering on races in an event having a plurality of races wherein the wager is for at least one dollar. Additionally, Brenner's system allows for the selection of event races to be included in a wager where a possible winner is selected for each of the races in the wager (*see col. 4: ln 22-42*). Additionally, Brenner's system gives a payout to the player if a predetermined number of selected winners win corresponding chosen races. However, Brenner is silent with regard to the method of wagering wherein the selected races are not run consecutively.

In an analogous reference, TAB teaches about the different type of wagers that can be placed on multiple races that are old and well known in the art. TAB teaches about "doubles and

trebeles" or bets which two or three races are designated. Additionally, TAB teaches about the

'pick6' wager in which the selection of the predicted winners of each of six races is made. These

multiple race options simply state that multiple race events may be included in a wager.

Although they do not specifically state that races wagered are not run consecutively it would not

be beyond one of routine to recognize that any combination of racing events could be included in

a multiple race wager as taught above. The idea that the races are run consecutively or not

consecutively does not change the concept of a multiple event wager, which is old and well

known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the

time the invention was made to incorporate the teaching of TAB about the different types of

multiple races with the invention of Brenner in order to derive the method of wagering wherein

the selected races are not run consecutively.

Response to Arguments

Applicant's arguments filed 4/9/07 have been fully considered but they are not

persuasive. The applicant's arguments with respect to claim 1 are state that Brenner fails to

disclose "allowing a player to choose a plurality of the event's races to be included in the

wager". Examiner respectfully disagrees. The prior art of Brenner is directed towards the ability

to allow a player to place a wager on an interactive wagering system and therefore implicitly and

inherently allows a player to choose which races to be included in the wager placed.

Additionally, the applicant's representative argues that the Examiner may be conflating elements

of a "pick-n" bet with that of the more general capabilities of the system. The Examiner

respectfully disagrees. The general elements of the prior art of Brenner are directed towards

managing and allowing a user to place bets. The general capabilities of the system allow a

player to place a bet or wager and limits these wagers to a predetermined quantity. However, encapsulated within the general capabilities of the system, Brenner allows a user to select several different types of bets. While most of these bets such as a win, place, or show have a predetermined quantity of one to be made, others such as a daily double or pick-n bet necessitate a limitation of allowing the user to have a predetermined quantity of selections to be 2 or "n". The current claims limitations have not precluded the Examiner from taking either interpretation and have not differentiated the difference between these two interpretations. Out of consideration the Examiner has incorporated both interpretations applied to Brenner in order to expedite prosecution. Furthermore, the applicant's representative argues that Brenner does not require a player to choose a number of chosen races equal to the predetermined quantity. Examiner respectfully disagrees as shown in the arguments presented about the daily double, win, place, show, and pick-n bets selections that Brenner is capable of placing.

The applicant also argues that Brenner fails to disclose "paying the player if a predetermined number of the selected winners win corresponding to the chosen races". Examiner strongly disagrees. As stated, in the remarks, Brenner states that "following a race, a user's wager is successful, the wagering data management system credits the user's account accordingly". The questions this argument as if a player has made a wager and the management system has credited the user's account accordingly, wouldn't the system have effectively paid a player? The system would not credit the system until the conditions of the wager had been met, therefore in bet such as a pick-n if a predetermined number of selected winners win the corresponding chosen races then the player in Brenner would have been paid out.

The applicant's arguments are repeated for claims 4-6, 14-15, and 27 and have already

been addressed in the remarks above. Additionally, the amended claim 9 has been address in the

office action above and the applicant's representative is kindly asked to refer to the rejection in

the instant office action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Mir et al. (US 6,358,150 B1) – Methods and Apparatus For Parimutuel Historical

Gaming.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ryan Hsu whose telephone number is (571)272-7148. The

examiner can normally be reached on 9 :00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Robert E. Pezzuto can be reached on (571)272-6996. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RH
June 22, 2007

/Scott Jones/

Primary Examiner, Art Unit 3714